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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,498	02/22/2002	Shigeru Hosoe	02860.0707	9353

7590 11/01/2004

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Washington, DC, 20005

EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,498

Applicant(s)

HOSOE, SHIGERU

Examiner

Carlos Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) 22-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Response to Amendment

The substitute specification filed on 8/6/04 has been entered.

After further review, the rejections of claims 1-21 have been withdrawn.

The applied references only provide a layer to the die base body. The coated layer can't be considered a die base body since the art distinguishes term "die base body" from that of a coating/layer. New rejections of claims 1-21 follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1) Claims 1, 3-18 and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-217 257 ('257), for which the machine translation is being referred. Machine translation of '257, paragraph 5 and 22 disclose an amorphous alloy mold base 1a and 1b

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having a super-cooled liquid phase containing, among other elements, aluminum at a 10mol%. The claimed die face is deemed as cavity section 8, formed by the pressing of master die 4 onto mold base 1a. Claims 1, 3-18 and 21 have been treated as product by process claims. As noted in MPEP 2113:

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In the instant case the claimed process as recited in claims 1, 3-9 and 21 are deemed to not add further structural limitations that would distinguish the claimed mold die with the mold die of the '275 reference. Alternatively, even if its deemed that the process limitation does further add structural limitations, it would have been obvious to a person of ordinary skill in the art at the time the invention was made that said processes steps are taken to form the mold base of '257.

In regards to claims 10-16, the process limitations refer to an alternative function of the mold, molding optical elements, and which in view that the mold face of '257 has the claimed hollows and protrusion, it would be expected to have the claimed effect on the optical element being worked on by the mold.

As for claims 17-18, '257 notes that the hardness HV is noted as 510, see machine translation paragraph 22.

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2) Claims 19-20 are rejected under 35 U.S.C. 103(a) as unpatentable over JP 10-217 257 ('257), the machine translation is being referred, as applied to claim 1 above and in further view of Inoue et al (US 6,521,058). '257 is silent adding palladium to the amorphous alloy composition. However, Inoue teaches that adding palladium to the composition of an alloy, strengthens it (Col.3, lines 3-8). At the time the invention was made it would have been obvious to a person of ordinary skill in the art to have added palladium to the alloy composition of '257 in order to strength the resultant mold.

In regards to claim 20, it would have been obvious to a person of ordinary skill in the art to conduct routine experiments to determine the optimum amount of palladium added to the alloy composition in view of Inoue teaching that palladium strengthens alloys.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3) Claims 1-8 and 19-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 and 8 of copending Application No. 10/079496 ('496). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 2-3 of copending Application No. 10/079496 recite the claimed mold die for an optical element having an amorphous alloy palladium and aluminum as noted in claim 3 and 8 of '496. While claims 3 and 8 of '496 do not disclose a die face, it is obvious to a person of ordinary skill in the art that the mold would have a die face.

As for claims 3-8, the claimed process for making the claimed mold does not provides additional structural features that would distinguished if from the '496 mold. Furthermore, the claimed process would be obvious to a person of ordinary skill in the art in order to make the mold of '496.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4) Claims 17-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 8 of copending Application No. 10/079496 ('496) in view of JP 10-217257. Claims 3 and 8 of '496 are silent disclosing the hardness of the mold die.

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However, '257 notes the hardness HV of an amorphous alloy having a super cooled liquid phase is 510 (see machine translation paragraph 22). Thus at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have '496's mold die with hardness HV 510 as disclosed by '257 in order to assure that it has sufficient strength to mold the desired product.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
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